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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,547	06/14/2006	Patrick Schiffrine	0512-1318	9488
465 7590 12/08/2009 YOUNG & THOMPSON 209 Madison Street Suite 500 Alexandria, VA 22314			EXAMINER FISHER, ELANA BETH	
			ART UNIT 3733	PAPER NUMBER
			NOTIFICATION DATE 12/08/2009	DELIVERY MODE ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

### Office Action Summary

**Application No.**

10/564,547

**Applicant(s)**

SCHIFRINE ET AL.

**Examiner**

ELANA B. FISHER

**Art Unit**

3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 3-8 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 and 3-8 is/are allowed.
- 6) ☒ Claim(s) 19-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 19 recites the limitation "the upper surface of the tibial plate" in fifteenth line of the claim. There is insufficient antecedent basis for this limitation in the claim.
3. Claim 19 recites the limitation "the upper surface of the tibia" in the seventeenth line of the claim. There is insufficient antecedent basis for this limitation in the claim.
4. Claim 20-21 recites the limitation "the mounting element" in the seventh line of claim 20. There is insufficient antecedent basis for this limitation in the claim.
5. Claim 23 recites the limitation "the connecting element" in the sixteenth and seventeenth lines of the claim. There is insufficient antecedent basis for this limitation in the claim.
6. Claim 24 recites the limitation "the lowermost planar surface" in the fourth and fifth lines of the claim. There is insufficient antecedent basis for this limitation in the claim.
7. Claim 24 recites the limitation "the displacement component" in the sixth line of the claim. There is insufficient antecedent basis for this limitation in the claim.
8. Claim 24 recites the limitation "the displacement element" in the eighth line of the claim. There is insufficient antecedent basis for this limitation in the claim.
9. Claim 25 recites the limitation "the upper most surface of the tibial cut" in the third and fourth lines of the claim. There is insufficient antecedent basis for this limitation in the claim.
10. Claim 25 recites the limitation "the displacement component" in the fifth and six lines of the claim. There is insufficient antecedent basis for this limitation in the claim.

11. Claim 25 recites the limitation "the lower surface" in the eighth line of the claim. There is insufficient antecedent basis for this limitation in the claim.

12. Claim 25 recites the limitation "the displacement element" in the tenth line of the claim. There is insufficient antecedent basis for this limitation in the claim.

13. Claim 25 recites the limitation "the rod plate" in the tenth and eleventh lines of the claim. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

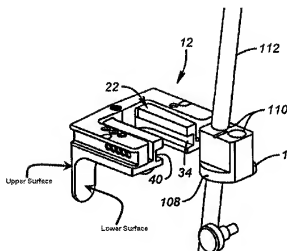
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 19, 22-23 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Burkinshaw et al. (U.S. Patent 6,290,704).

Claims 19 and 22:

Burkinshaw et al. disclose a device for positioning a total knee prosthesis, comprising: a medullary rod (112) having a proximal end, the medullary rod configured to be introduced into a femoral medullary canal; a rod base (14) attached to the proximal end of the medullary rod, the rod base having i) a face (bottom of 14; FIG 1) configured to contact the femoral condyles when the medullary rod is disposed within the femoral medullary canal, and ii) a base mounting element (106, 108); a tibial plate (26) having a lowermost surface (see diagram provided) configured to be supported on an upper surface of a tibial cut; and a displacement element (28) comprising a distal end extending from the tibial plate and being attachable to the base mounting element such that the medullary rod (112) is approximately parallel to the upper surface (see diagram provided) of the

The displacement element (28) comprises a slide housing (12) extending from the upper surface of the tibial plate (26) and a slide (34, 40) displaceable on the slide housing. The rod base (14) mounts to the slide (34, 40), and the rod base (14) when mounted on the slide is positioned approximately perpendicular with the upper surface of the tibial plate (FIG 1).



Claims 23 and 26:

Burkinshaw et al. disclose a device for displacing a tibia and a femur, the tibia having a tibial axis and a cut proximal surface, and the femur having a femoral medullary canal, comprising: an ancillary component comprising a medullary rod (112) and an attachment part (14) attached at a proximal end of the medullary rod, the medullary rod configured to be introduced into the femoral medullary canal; a tensioning device comprising: i) a tibial plate (26) configured to be supported on an uppermost surface of

the cut tibia, ii) a first component (28) that is attached at one end to the tibial plate, and iii) a second component (106,108) that is attached to the attachment part (14) of the ancillary component, wherein, the first component and the second component are movable with respect to one another so as to displace the tibial plate (26) between i) a first position wherein the medullary rod (112) and tibial plate (26) are separated by a first distance as measured along the tibial axis, and ii) a second position wherein the medullary rod (112) and tibial plate (26) are separated by a second distance as measured along the tibial axis, the second distance being greater than the first distance (FIG 1). The first component (28) comprises a slide housing (34, 40) and the second component (106, 108) is a slide, with the slide being configured to slide with respect to the slide housing (FIG 1).

***Allowable Subject Matter***

15. Claims 1 and 3-8 are allowed.

***Response to Arguments***

16. Applicant's arguments with respect to claims 19-26 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELANA B. FISHER whose telephone number is (571)270-3643. The examiner can normally be reached on Monday through Friday from 8:30AM to 5:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571)272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Elana B Fisher/  
Examiner, Art Unit 3733  
/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733